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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,406	04/15/2004	Anton Franz Josef Fliri	PC9868D	9380

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PFIZER INC
150 EAST 42ND STREET
5TH FLOOR - STOP 49
NEW YORK, NY 10017-5612

EXAMINER

BERNHARDT, EMILY B

ART UNIT PAPER NUMBER

1624

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,406

Applicant(s)

FLIRI ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

In view of applicants' response filed 1/25/05 the following applies.

Parent history is still incomplete. In the **Application data sheet** , there are listed 2 earlier cases, namely, 09/423064 which PTO records indicate 09/842,569 is a CON of said case and an earlier US provisional case which lacks copendency with 09/423064. Applicants' oath identifies this case as going back to a 371 case which is not identified in the priority information. Correction is needed to avoid printer's queries. Also, parent history added to specification should be deleted as it is also incomplete and not necessary in view of the Data sheet. See MPEP 201.11. Also applicants should request a corrected filing receipt since one of the inventors who signed the original oath is not listed in the BIB DATA sheet, namely inventor Zorn.

Applicant's election of Group I in the reply filed on 1/25/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Newly submitted claim 22 (in part) is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: It contains species not part of the genus as originally presented which has thus not been searched in the 1st office action and consists of the following:

A. Pentalene species which lack the indole core and are separately and variously classified- these appear throughout most of claim 22;

B. Methanone species which have the indole core but would correspond to a C(O) link between said core and the azine ring which has not been searched;

C. Naphthylene species which have the indole core but have naphthyl in place of the T-Y-Z ring previously presented; and

D. one benzo[d]isothiazole species which replaces the indole core .

Such compounds are made independently of each other and may raise additional issues of patentability apart from that previously set forth and maintained below.

Since applicant has received an action on the merits for the originally presented invention, this invention (i.e. 12 species on p.4 of claim 22) has been constructively elected by original presentation for prosecution on the merits. Accordingly, said subject matter in claim 23 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Note also azaindoles, part of Group III, are present in claim 23 as the last 2 species.

Applicants are also advised that only psychotic disorders has been examined on the merits. Said uses are embraced by claims 24 and 25 both in part as well as covered by claim 26. Rejoinder of remaining uses is only possible if corresponding compound claims are allowed, which is not the case.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulagowski for reasons of record. While species embraced by these claims are not anticipated they are obvious variants as the nature of substituents present on the phenyl ring and/or indole ring are within the preferred embodiments set forth on p.9 of the WO publication. In fact it is well settled that a reference is not limited to its preferred embodiments or working examples but for all that it fairly teaches. See *In re Lamberti* 192 USPQ 278; *In re Mills* 176 USPQ 196; *In re Burckel* 201 USPQ 67 regarding the latter point. Given the similar activities and uses urged and the suggestion to replace exemplified moieties (in species previously pointed out) with that claimed herein, the rejection is believed proper and is thus maintained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Emily Bernhardt
Primary Examiner
Art Unit 1624